

REMARKS/ARGUMENTS

In response to the Office Action mailed May 27, 2009, Applicant amends his application and requests reconsideration. No claims are added or cancelled so that claims 1-23 remain pending.

This Amendment

In this Amendment the claims are amended for clarity. Claim 1 remains the sole pending independent claim. Claim 1 is amended in several ways to explain the machines, i.e., computers, to which the claimed method is tied in performing the method. These descriptions are entirely supported by the patent application as filed.

Of course, reference was previously made to a user network access device which allows a user, performing part of the method, to communicate via an electronic network. Examples of such user network access devices are described in the paragraph on page 10 that begins in line 20. Those devices include a computer, a personal digital assistant, and mobile phones according to the description provided there. In the method, a user, using his network access device, communicates, through an electronic network, such as the Internet and other networks as described from page 9, line 28 through page 10, line 4, with providers of goods and services. Each provider has a provider server that responds to the inquiries made by a user. The provider servers are identified with the letter P, with or without a suffix, in figures of the patent application.

Further, the system server, sometimes referred to as a central server, is located at a central site according to the patent application. This system server provides the payment distribution that is extensively described in the patent application. Of course, many of the calculations and much of the record keeping may be carried out by the user network access device, as described in the patent application. The system server is referred to throughout the patent application and a succinct description of it appears in the paragraph at page 9, lines 11-26 of the patent application.

Figures 1-3a illustrate alternative methods of communication according to the system, for example, through the central site, i.e., system server, and between a provider server and a user network access device, and direct communication between a provider server and a user network access device through which the system server is only employed in distributing the respective percentage shares of the fixed user fee.

In addition to the described amendments in claim 1, there are further amendments in that claim and other claims to correct minor errors that were not previously identified.

The dependent claims that describe processes employing machines are amended for clearer description of the interaction with the machines in carrying out the method. For example, claims 2 and 3 are amended to describe expressly that, in claim 2, there is a direct communication between a provider server and a user network access device without the interaction of the system server. Claim 3 provides for the communication between a provider server and the user network access device through the system server. When these different communication routes are used, the usage data, used in calculating percentage shares of the fixed fee to be distributed, are accumulated in different locations, as expressly described in claims 4-7. Depending upon the location of that data accumulation, consolidation of the usage data on the system server requires or does not require particular communication with the user network access device. Of course, in a contemplated system, there are multiple users with respective network access devices, as described in claims 12-17. These claims, as well as claim 22 are amended to describe more specifically how the method that is claimed is tied to specific hardware.

The Invention

As previously described and as is described in the patent application, the invention pertains to a system in which a subscriber or user pays a fixed user fee for a fixed-length billing period, for example, one month, to gain access via the user network access device, over an electronic network, to the provider servers of a number

of different providers, regardless of the degree of usage made of a particular provider's server. A single source, through a system server, bundles the providers as if they were one information source. The user may access only a few, a large fraction of, or all of the provider servers of providers of products and services of the bundled source. Then, to compensate the providers for use of their provider servers, a calculation is made, based upon the relative usage of each of the provider servers. Based upon that usage determination, in accordance with the claims and the disclosure of the patent application, the user fee is divided into respective percentage shares for each provider whose server has been accessed during the billing period. Using the system server, both frequently accessed provider servers and those provider servers only rarely used, can obtain revenue that might not otherwise be available if each provider had to individually merchandize his products and services.

A subsidiary and important feature of the invention is that a user program, i.e., software, for implementing the system must be installed and run on each user's network access device. In addition, a system program must be run on the system server to establish the system for practicing the invention.

Further novel features of the invention are described in dependent claims 19-21. These features include eliminating payments to providers whose respective percentage shares for provider server access are minimal. For example, according to claim 19, the smallest shares are not paid to the providers. With respect to claim 20, the maximum number of providers that receives a payment in each distribution is limited to a specific number. The example provided in the patent application is 50 such providers. If that threshold is employed, then any percentage shares for a 51st and higher provider for a particular fixed-length billing period are simply not made. According to the feature of claim 21, if the respective percentage share falls below a particular percentage of the fixed user fee, then payment is not made. The cutoff is made regardless of the number of providers otherwise qualifying and regardless of the degree of usage. The purpose of these features is simply to avoid an unmanageable number of payees and/or unduly small payments.

The Section 101 Rejection

Claims 1-23 were rejected as not directed to statutory subject material, failing the machine-or-transformation test. Applicant respectfully traverses this rejection.

While the statement of the rejection appears to be a recitation of concepts discussed in *In re Bilski*, 88 USPQ 2d 1385 (Fed. Cir. 2008), reference is not made to that opinion. The *Bilski* opinion makes clear that when a method is sufficiently tied to specific hardware, the method is patentable pursuant to 35 USC 101, notwithstanding the failure of the method to transform a physical article.

The invention described and claimed in the patent application is tied to specific hardware as discussed above in connection with the amendments made to the claims. The hardware comprises, at minimum, multiple provider servers, a system server, and at least one user network access device, all communicating with each other through an electronic network. Therefore, the invention as defined by the pending claims meets the requirements of the machine-or-transformation test enunciated in *Bilski* and now subject to review at the U.S. Supreme Court. Contrary to the assertion of the Office Action, the Supreme Court has not yet acted with respect to the machine-or-transformation test, which does not appear in precedential opinions of that Court.

The Prior Art Rejection

Claims 1-23 were again rejected as obvious over Justice (Published U.S. Patent Application 2001/0049630). This rejection is again respectfully traversed.

It appears that the prior art rejection based upon Justice is identical to the previous rejection based upon Justice, with some adjustment of the language to account for the amendments of the claims in the previous Response. Therefore, Applicant again presents nearly the same arguments previously presented against the prior art rejection which has, in effect, not yet received a reply. The reply was that the rejection was moot because of a new rejection. However, the new rejection is the rejection pursuant to 35 USC 101, discussed above, entered in combination with the

previously existing prior art rejection. Thus, the prior art rejection appears to have been maintained rather than being moot.

Response to Prior Art Rejection

Justice relates to system for subscribing to Internet services and paying for products and services purchased through that access. According to Justice, there is a fixed monthly or periodic access service fee for access to the Internet and there is, in addition, a charge according to the sale price of any goods or services that are purchased. There is no division of the fixed periodic access fee amongst providers. There is no suggestion for such a division and, on that basis alone, Justice cannot suggest the invention as defined by any pending claim.

A review of the portions of Justice cited in the Office Action as supporting the rejection and all of the description of Justice, fails to establish *prima facie* obviousness as to claim 1, and, therefore, as to any of claims 2-23. Justice never describes calculating respective percentage shares of a fixed user fee and distributing those respective percentage shares to providers. The only basis upon which it is asserted that there is such a disclosure in Justice is Figure 1 of that publication. However, there is no indication in that figure, or in the description of that figure, of any division of any fixed amount amongst service providers.

Justice does describe that a user of his system has payments tracked to respective vendors. According to paragraph [0020], a customer requests a purchase of an item from a vendor. This purchase has nothing to do with a fixed periodic user access fee. In fact, in paragraph [0077], Justice differentiates between “the customer’s monthly ISP bill” and payment for particular additional products and services. According to that paragraph, the system described by Justice “mirrors long distance telephone billing which has been used for decades and is a familiar process to customers.” Further, in pointing out the alleged advantages of his system, at paragraphs [0082] and [0083], Justice describes the aggregation of a consumer’s

purchases and the provision of a monthly summary of the additional purchases, over the basic monthly access fee, “just like a telephone bill.”

What Justice describes has no relationship to dividing a fixed monthly fee amongst numerous providers based upon usage of the providers’ servers. The Office Action acknowledges that Justice does not expressly show calculating a payment distribution by dividing a user fee. Of course, the reason Justice does not expressly describe such a distribution is that Justice does not contemplate such a percentage distribution of a fixed monthly fee. The assertion in the paragraph bridging pages 3 and 4 of the Office Action to the contrary is not supported by any part of the disclosure of Justice.

Allegedly, the assertion that Justice describes a percentage distribution is supported by paragraph [0089] of Justice. The cited paragraph, referring to two specific Internet service providers, states that the “providers are paid for the timed usage of their content by the premium services which subsequently charge their users *by the hour*.” This passage does not describe the division of a fixed periodic user access fee amongst providers. Rather, what is described is the payment of additional fees for premium services on top of monthly user access fees, which is the antithesis of the invention. In the invention premium and non-premium services are bundled so that the user can have access to as many of the bundled providers as he chooses. The providers of those products and services will not receive a payment based upon what the premium providers charge by the hour. The providers will receive a payment that is a percentage of a fixed amount paid on a regular, e.g., monthly, basis. Justice, in its paragraph [0089] has been interpreted in a way exactly opposite from its disclosure.

In the invention as defined by claim 1, as already described, software must be installed on the network access device of each user. According to the Office Action at page 3, Justice describes installing and running a client program on each user’s network access device. Paragraph [0020] of Justice was cited as allegedly supporting this assertion. Applicant respectfully disagrees with the Examiner’s position.

Paragraph [0020] of Justice only describes a browser on the user side as a software application. Browsers are essentially universally installed at the user side, i.e., at the user network access device, no matter whether the Justice system or the present invention is employed. In paragraph [0020], and other paragraphs of Justice, there is a description of the placing of cookies on the user network access device. However, cookies are not a client program. Moreover, Justice makes clear that no client program is installed on a user network access device. See paragraph [0078] of Justice.

“The MicroTrack method requires no additional software at the consumer level. Most browsers currently used by users of the public computer communications network (like the Internet) have to ability to accept and use cookies as defined above. *Thus, no additional software is needed on the client (purchaser) computer.*” (Emphasis added.)

Because of these two important differences between what is described in Justice and what is claimed in claim 1, *prima facie* obviousness of claim 1, and, therefore, of claims 1-23, cannot be established based upon Justice alone. The acknowledged differences between the claimed invention and Justice, contrary to the Office Action, are not suggested by Justice.

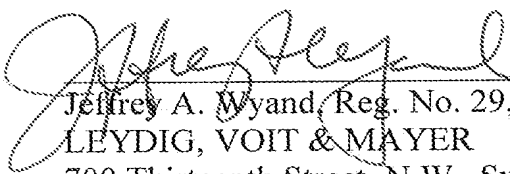
Because of the differences between the invention as defined by claim 1 and Justice, it is not necessary to provide additional explanation and differentiation between any of claims 2-23 and Justice. Nevertheless, Applicant separately traverses the rejection of claims 19-21. Claims 19-21 were not rejected based upon Justice alone. Rather, to supply the parts of those claims acknowledged to be absent from Justice, the Examiner defaulted to “Official Notice.”

Applicant traverses the alleged “Official Notice” taken by the Examiner. The Official Notice presumes that Justice describes the distribution of respective percentage shares of a fixed user access fee. However, there is no such description in Justice. Further, the Office Notice seems to be based upon individual income taxation in the United States, a system which has no relationship whatsoever to the invention

claimed. The graduated income tax rate scheme does not excuse any taxpayers from paying tax on the basis that low percentage shares of the total tax are not paid as in claims 19-21. There is no exemption from payment on the basis that a taxpayer's share of the total tax revenue is too small to be of any value and therefore can be neglected. Likewise, Applicant's representative is unaware of any tax provision that permits, once a certain number of taxpayers pay tax, that, as apparently analogized to claim 20, the remaining taxpayers need not pay tax. The alleged "Official Notice" is erroneous and is improper because it has no relationship to either Justice or the present invention. The Official Notice should be withdrawn. Claims 19-21 are clearly patentable over Justice, independent of the patentability of claim 1.

Reconsideration, withdrawal of the rejection, and allowance of claims 1-23 are earnestly solicited.

Respectfully submitted,


Jeffrey A. Wyand, Reg. No. 29,458
LEYDIG, VOIT & MAYER
700 Thirteenth Street, N.W., Suite 300
Washington, DC 20005-3960
(202) 737-6770 (telephone)
(202) 737-6776 (facsimile)

Date: November 24, 2009
JAW:ves